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EXAMINER

PARRA, OMAR S

ART UNIT PAPER NUMBER

2621

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/763,580

Applicant(s)

CARNEY ET AL.

Examiner

Omar Parra

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01/23/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. Preliminary amendment to the Specification submitted on 05/24/2004 was acknowledged by Examiner for prosecution purposes.

### *Claim Objections*

2. Claims 7 – 8,18-19 and 27-28 are objected to because of the following informalities: Inconsistent terminology. In the first line of said claims, the phrase “wherein any component VOD clips” lacks clarity and precision. As construed by the examiner for prosecution purposes, those “any component VOD clips” are referring to “the one or more corresponding VOD clips” as stated in claim 1. Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-30 rejected under 35 U.S.C. 102(e) as being anticipated by Begeja et al. (Pub. No. US 2003/0030752).
5. Consider **Claim 1**, Begeja et al. teaches a method comprising:

providing a list or lists of one or more video-on-demand (VOD) (“the present invention allows improved video-on-demand (VOD)”, [0031] paragraph lines 1-2) clip categories each VOD clip category containing one or more corresponding VOD clips (“...clips are listed both by topic and by number of clips related to that topic” paragraph [0059] lines 9-10 or see 405, Fig.4);

receiving user input , the user input specifying at least one VOD clip category (“In section 405, the user has the option of viewing one or more of the clips related to a particular topic”, [0059] paragraph 10-12 –the 405 refers to Fig. 405) ;and

automatically creating a composite VOD clip (“Once the pertinent segments of the broadcast have been appropriately extracted, for a given user, they can be stitched together for continuous delivery to that user” [0025] paragraph lines 1-3) based upon the specified at least one VOD clip category (515, Fig.5-topic “Politics” was chosen); wherein the composite VOD clip consists of each of the one or more corresponding VOD clips of each specified VOD clip category (505, Fig. 5-clips pertaining to “Politics” topic).

6. Consider **claim 2**, and as applied on claim 1, Begeja et al. teaches a method comprising:

presenting the composite VOD clip to a user to effect a passive viewing experience (“...a show automatically starts and will play completely through if not interrupted by the user”, [0053] lines 19-20).

7. Consider **claim 3**, and as applied on claim 2, Begeja et al teaches a method comprising:

providing a list of one or more VOD clip parameters (Buttons 520-580, Fig. 5), each of the VOD clip parameters pertaining to a subset of the one or more VOD clips (505, Fig.5) corresponding to a VOD clip category (515, Fig. 5).

8. Consider **claim 4**, and as applied on claim 3, Begeja et al teaches a method comprising:

receiving further user input, the further user input specifying at least one of the one or more VOD clip parameters ("With buttons 560 and 565,"-referring to Fig.5- "a user may clear or select all of the clips being shown within a particular topic.", [0066] paragraph lines 9-10), wherein the composite VOD clip consists of the subset of the one or more VOD clips (505, Fig.5) corresponding to the selected VOD clip parameters in each specified VOD clip category (565, Fig.5).

9. Consider **claim 5**, and as applied on claim 4, Begeja et al teaches a method wherein the one or more VOD clip parameters includes a VOD clip parameter selected from the group consisting of a random selection parameter (420, Fig.4, "Play all clips" without knowing what's going to play is a random selection), a maximum number parameter, a maximum time parameter (505, Fig.5, by checking the check boxes users are able to choose the maximum time and maximum number of clips for his composite video clip), and a sequential parameter ("...page 500 will play all the clips in a predetermined order (e.g. reverse chronological order, by source of content, etc", [0065] lines 2-4).

10. Consider **claim 6**, and as applied on claim 1, Begeja et al teaches a method wherein the composite VOD clip is automatically regenerated ("When such a profile is

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available, the present invention is capable of automatically searching the available assets... and thereafter extracting, combining and delivering the compiled assets..."

[0026] paragraph-lines 7-10) upon user request ("instant search", [0058], paragraph-line 2) or according to an externally specified schedule ("...on a periodic basis..."[0026], line 9).

11. Consider **claim 7**, and as applied on claim 1, Begeja et al. teaches a method wherein any component VOD clips made available prior to a specified time (405, Fig.4, videos are available prior user's selection) are removed ("AT&T, 8 clips", "Jay Lenos White H... 10 clips", "Sports, 6 clips", see Fig.4, are removed after choosing "Politics") from the composite VOD clip (505, Fig.5).

12. Consider **claim 8**, and as applied on claim 1, Begeja et al teaches a method wherein any component VOD clips previously presented to a particular user (405, Fig.4, videos are presented to the user for selection) are removed ("AT&T, 8 clips", "Jay Lenos White H... 10 clips", "Sports, 6 clips", see Fig.4, are removed after choosing "Politics") from the user's composite VOD clip (505, Fig.5).

13. Consider **claim 9**, and as applied on claim 1, Begeja et al. teaches a method wherein one or more additional VOD clips are included as component VOD clips of the composite VOD clip ("The user can add a new topic using button 425, Fig.4" [0062] paragraph line 3, which inherently would add more clips to the composite video)

14. Consider claim 10, and as applied on claim 1, Begeja et al teaches a method wherein the one or more additional VOD clips is a VOD clip selected from the group consisting of advertising VOD clips ("Additional marketing and advertising (such as a

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commercial placed between every third clip stitched together) could be tied into the video stream..." [0057] paragraph lines 19-21), promotional VOD clips pertaining to VOD content unrelated to the composite VOD clip ("Additional marketing and advertising (such as a commercial...)", [0057] paragraph lines 19-20), and promotional VOD clips pertaining to VOD content related to the composite VOD clip ("Relevant information that might be embedded into a media stream being delivered...might include...information about the subject matter of the stream or related thereto, such as advertising...", [0087] paragraph lines 1-4).

15. Consider **claim 11**, and as applied on claim 1, Begeja et al teaches a method wherein one or more additional graphical or data contents, including content tickers, graphical ads or promotional contents unrelated to the composite VOD clip, and content tickers, graphical ads or promotional contents related to the composite VOD clip ("Additional possibilities for embedding into the media stream include graphics, games, text, pictures and other types of known media assets.", [0087] paragraph lines 5-7 or also, 555, Fig.5) are added alongside or partially overlay the composite VOD clip.

16. Consider **12**, Begeja et al. teaches having a machine-readable medium having stored thereon executable instructions which when executed by a processor cause a method to be performed ("DVL/eClips Server" or "PC or Set Top" memory units where eClips software runs ,see Fig.3), the method comprising:

providing a list or lists of one or more video-on-demand (VOD) ("the present invention allows improved video-on-demand (VOD)", [0031] paragraph lines 1-2) clip categories each VOD clip category containing one or more corresponding VOD clips

("...clips are listed both by topic and by number of clips related to that topic" paragraph [0059] lines 9-10 or see 405, Fig.4);

receiving user input , the user input specifying at least one VOD clip category ("In section 405, the user has the option of viewing one or more of the clips related to a particular topic", [0059] paragraph 10-12 –the 405 refers to Fig. 405) ;and

automatically creating a composite VOD clip ("Once the pertinent segments of the broadcast have been appropriately extracted, for a given user, they can be stitched together for continuous delivery to that user" [0025] paragraph lines 1-3) based upon the specified at least one VOD clip category (515, Fig.5-topic "Politics" was chosen); wherein the composite VOD clip consists of each of the one or more corresponding VOD clips of each specified VOD clip category (505, Fig. 5-clips pertaining to "Politics" topic).

17. Consider **claim 13**, and as applied on claim 12, Begeja et al. teaches a method comprising:

presenting the composite VOD clip to a user to effect a passive viewing experience ("...a show automatically starts and will play completely through if not interrupted by the user", [0053] lines 19-20).

18. Consider **claim 14**, and as applied on claim 13, Begeja et al. teaches a method further comprising:

providing a list of one or more VOD clip parameters (Buttons 520-580, Fig. 5), each of the VOD clip parameters pertaining to a subset of the one or more VOD clips (505, Fig.5) corresponding to a VOD clip category (515, Fig. 5).



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19. Consider **claim 15**, and as applied on claim 14, Begeja et al. teaches a method further comprising:

receiving further user input, the further user input specifying at least one of the one or more VOD clip parameters ("With buttons 560 and 565,"-referring to Fig.5- "a user may clear or select all of the clips being shown within a particular topic.", [0066] paragraph lines 9-10), wherein the composite VOD clip consists of the subset of the one or more VOD clips (505, Fig.5) corresponding to the selected VOD clip parameters in each specified VOD clip category (565, Fig.5).

20. Consider **claim 16**, and as applied on claim 15, Begeja et al. teaches a method wherein the one or more VOD clip parameters includes a VOD clip parameter selected from the group consisting of a random selection parameter (420, Fig.4, "Play all clips" without knowing what's going to play is a random selection), a maximum number parameter, a maximum time parameter (505, Fig.5, by checking the check boxes users choose the maximum time and maximum number of clips for their composite video clip), and a sequential parameter ("...page 500 will play all the clips in a predetermined order (e.g. reverse chronological order, by source of content, etc", [0065] lines 2-4).

21. Consider **claim 17**, and as applied on claim 12, Begeja et al. teaches having the composite VOD clip is automatically regenerated ("When such a profile is available, the present invention is capable of automatically searching the available assets... and thereafter extracting, combining and delivering the compiled assets..." [0026] paragraph-lines 7-10) upon user request ("instant search", [0058], paragraph-line 2) or

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according to an externally specified schedule (“...on a periodic basis...”, paragraph [0026] line 9).

22. Consider **claim 18**, and as applied on claim 12, Begeja et al. teaches having any component VOD clips made available prior to a specified time (405, Fig.4, videos are available prior user’s selection) are removed (“AT&T, 8 clips”, “Jay Lenos White H... 10 clips”, “Sports, 6 clips”, see Fig.4, are removed after choosing “Politics”) from the composite VOD clip (505, Fig.5).

23. Consider **claim 19**, and as applied on claim 12, Begeja et al. teaches having any component VOD clips previously presented to a particular user (405, Fig.4, videos are presented to the user for selection) are removed (“AT&T, 8 clips”, “Jay Lenos White H... 10 clips”, “Sports, 6 clips”, see Fig.4, are removed after choosing “Politics”) from the user’s composite VOD clip (505, Fig.5).

24. Consider **claim 20**, and as applied on claim 12, Begeja et al. teaches having one or more additional VOD clips are included as component VOD clips of the composite VOD clip (“The user can add a new topic using button 425, Fig.4” [0062] paragraph-line 3, which, according to the invention, inherently would add more clips to the composite video).

25. Consider **claim 21**, and as applied on claim 12, Begeja et al. teaches having the one or more additional VOD clips is a VOD clip selected from the group consisting of advertising VOD clips (“Additional marketing and advertising (such as a commercial placed between every third clip stitched together) could be tied into the video stream...” [0057] paragraph lines 19-21), promotional VOD clips pertaining to VOD content

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unrelated to the composite VOD clip ("Additional marketing and advertising (such as a commercial...)", [0057] paragraph lines 19-20), and promotional VOD clips pertaining to VOD content related to the composite VOD clip ("Relevant information that might be embedded into a media stream being delivered...might include...information about the subject matter of the stream or related thereto, such as advertising...", [0087] paragraph lines 1-4).

26. Consider **claim 22** Begeja et al. teaches a system comprising:

a server ("Video Server", 220 Fig.2, or "Video Storage", 210 Fig.2, if more storage is needed) storing VOD content ("the present invention allows improved video-on-demand (VOD)",[0031] paragraph-lines 1-2), the VOD content including a plurality of VOD clip categories ("...a user should see a list of topics determined by their profile...", [0051] paragraph lines 3-4), each VOD clip category containing one or more corresponding VOD clips ("...as well as the number of clips for each topic", [0051] paragraph lines 4-5); and

a set top box (370, Fig.3) coupled to the server (220, Fig.3), the set top box storing an application ("...where Settop box 370 runs eClips client 250", [0058] paragraph lines 4-5 or "The system may include a software client installed on a device of a user, and an interface for interacting with the software client to input a user search criterion", [0015] paragraph-lines 2-5 of incorporated by reference application ,Begeja et al. Pub. No. 2003/0163815), the application including a VOD clip category selection functionality ("...a user should see a list of topics determined by their profile..." [0054] paragraph-lines 3-4. Having a list of topics determined by a profile implies that there

was a functionality that lets to choose the topics at the creation of the profile) that enables a user to access the plurality of VOD clip categories and select one or more VOD clip categories, (“...a user should see a list of topics determined by their profile...”, [0051] paragraph-lines 3-4), and a VOD clip composite functionality that automatically creates a composite VOD clip (“Once the pertinent segments of the broadcast have been appropriately extracted, for a given user, they can be stitched together for continuous delivery to that user” [0028] ¶ lines 1-3) wherein the composite VOD clip consists of each of the one or more corresponding VOD clips of each selected VOD clip category (“...clips are listed both by topic and by number of clips related to that topic” paragraph [0059] lines 9-10 or see 405, Fig.4);

27. Consider **claim 23**, and as applied on claim 22, Begeja et al. teaches a system further comprising:

a display screen (380, Fig.3) for presenting the composite VOD clip to the user to effect a passive viewing experience.

Consider claim 24, and as applied on claim 23, Begeja et al. teaches having an application (“eClips”, Figs. 4-5) that further includes a VOD clip parameter selection functionality (Buttons, Drop-down menus and check boxes, Fig. 4-5) that allows a user to select one or more VOD clip parameters (“With buttons 560 and 565,”-referring to Fig.5- “a user may clear or select all of the clips being shown within a particular topic”, [0066] paragraph lines 9-10), each of the VOD clip parameters pertaining to a subset of the one or more VOD clips (505, Fig.5) corresponding to a VOD clip category (565, Fig.5) such that the created composite VOD clip consists of the subset of the one

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or more VOD clips corresponding to each selected VOD clip category ("When one or more of these clips (referring to clips in 505, Fig.5) is chosen for viewing by the user, that clip is shown in section 510" (Fig.5, playing area of the composite video) [0064] lines 1-2).

28. Consider **claim 25**, and as applied on claim 23, Begeja et al. teaches a system wherein the one or more VOD clip parameters includes a VOD clip parameter selected from the group consisting of a random selection parameter (420, Fig.4, "Play all clips" without knowing what's going to play is a random selection), a maximum number parameter, a maximum time parameter (505, Fig.5, by checking the check boxes users choose the maximum time and maximum number of clips for their composite video clip), and a sequential parameter ("...page 500 will play all the clips in a predetermined order (e.g. reverse chronological order, by source of content, etc", [0065] lines 2-4).

29. Consider **claim 26**, and as applied on claim 22, Begeja et al. teaches having a system wherein the composite VOD clip is automatically regenerated ("When such a profile is available, the present invention is capable of automatically searching the available assets... and thereafter extracting, combining and delivering the compiled assets..." [0026] paragraph-lines 7-10) upon user request ("instant search", [0058], paragraph-line 2) or according to an externally specified schedule ("...on a periodic basis...", paragraph [0026] line 9).

30. Consider **claim 27**, and as applied on claim 22, Begeja et al. teaches having a system wherein any component VOD clips made available prior to a specified time (405, Fig.4, videos are available prior user's selection) are removed ("AT&T, 8 clips", "Jay

Lenos White H... 10 clips", "Sports, 6 clips", see Fig.4, are removed after choosing "Politics") from the composite VOD clip (505, Fig.5).

31. Consider **claim 28**, and as applied on claim 22, Begeja et al. teaches having a system wherein any component VOD clips previously presented (405, Fig.4, videos are presented to the user for selection) to a particular user are removed ("AT&T, 8 clips", "Jay Lenos White H... 10 clips", "Sports, 6 clips", see Fig.4, are removed after choosing "Politics") from the user's composite VOD clip (505, Fig.5).

32. Consider **claim 29**, and as applied on claim 22, Begeja et al. teaches having a system wherein one or more additional VOD clips are included as component VOD clips of the composite VOD clip ("The user can add a new topic using button 425, Fig.4" [0062] paragraph-line 3, which inherently would add more clips to the composite video).

33. Consider **claim 30**, and as applied on claim 22, Begeja et al. teaches having a system wherein the one or more additional VOD clips is a VOD clip selected from the group consisting of advertising VOD clips ("Additional marketing and advertising (such as a commercial placed between every third clip stitched together) could be tied into the video stream..." [0057] paragraph lines 19-21), promotional VOD clips pertaining to VOD content unrelated to the composite VOD clip ("Additional marketing and advertising (such as a commercial...)", [0057] paragraph lines 19-20), and promotional VOD clips pertaining to VOD content related to the composite VOD clip ("Relevant information that might be embedded into a media stream being delivered...might include...information about the subject matter of the stream or related thereto, such as advertising...", [0087] paragraph lines 1-4).

### ***Conclusion***

34. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Following, there's a list of the prior art and the reason why they were considered pertinent:

<b>Prior Art</b>	<b>Reason to be pertinent</b>
Uehara et al. (Pub.No.US-2002/0056095)	Shows segmenting content and arranging them as icons.
Begeja et al. (Pub. No. US-2004/0025180)	Has the same content as primary reference.
Ellis et al. (Pub. No..US-2004/0117831)	Lets manipulate and search for video clips saved in a server.
Cuttner et al. (Pub. No. US-2004/0221308)	Provides an interface for viewing and a method for providing VOD content.
Logan et al. (Pub. No. US-2005/0005308)	Invention segments content and presents clips based on user preferences.
Ismail et al. (Pub. No. US-0204386)	Lets record content for later view based on user's preferences.
Maybury et al. (US-6, 961,954)	Segments and presents news summaries based on user's preferences.
Dudkiewicz et al. (Pub.No.US-2005/0246732)	Has an interface for navigating among lists of personalized content and for updating the user's preferences.
Price et al. (US-6, 986,154)	Presents content to user based on his/her preferences.

Swix et al. (Pub. No. US-2006/0031882)	Presents content to user based on his/her preferences.
Knudson et al.(Pub.No.US-2006/0095937)	Interactive television program guide that lets searching content by categories.
Thomas et al.(Pub. No. US-2003/0093794)	Presents content to user based on his/her preferences.
Bayrakeri et al.(Pub.No.US-2006/0184979)	Shows system and method for delivery of short-time duration video segments.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar Parra whose telephone number is 571-270-1449. The examiner can normally be reached on Under Academy Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a



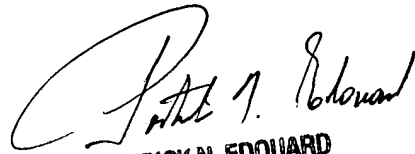
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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OP



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SUPERVISORY PATENT EXAMINER